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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/828,754	04/09/2001	Chung-Wei Wu	DEE-PT016	6486

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UNITED PLAZA, SUITE 1600  
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PHILADELPHIA, PA 19103

EXAMINER

DEAN, RAYMOND S

ART UNIT	PAPER NUMBER
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2684

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DATE MAILED: 12/19/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

TS

# Office Action Summary

Application No.

09/828,754

Applicant(s)

WU, CHUNG-WEI

Examiner

Raymond S Dean

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1 - 8 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1 - 8 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. §§ 119 and 120

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All b) ☐ Some \* c) ☐ None of:  
1. ☐ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).  
\* See the attached detailed Office action for a list of the certified copies not received.
- 13) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.  
a) ☐ The translation of the foreign language provisional application has been received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_ 6) ☐ Other: \_\_\_\_

## **DETAILED ACTION**

### ***Specification***

1. The disclosure is objected to because of the following informalities in the Detailed Description of the Preferred Embodiments section of specification: insert the word "by" between "approached" and "the" in lines 8, 18, and 23, insert the word "the" between "accesses" and "database" in line 10, change the word "provide" to "provided" in line 17, and change the words "an user" to "a user" in line 18. Appropriate correction is required.

### ***Drawings***

2. Figure 1 should be designated by a legend such as --Prior Art-- because only that which is old is illustrated. See MPEP § 608.02(g). A proposed drawing correction or corrected drawings are required in reply to the Office action to avoid abandonment of the application. The objection to the drawings will not be held in abeyance.

### ***Claim Rejections - 35 USC § 102***

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

4. Claims 1 – 3, and 8 are rejected under 35 U.S.C. 102(e) as being anticipated by Pecen et al. (US 6,466,804 B1).

Regarding Claim 1, Pecen teaches a mobile phone capable of being activated by a signal transmitted from an activation device, comprising: an IC card driver connected with a communication system for communicating with others; and an access module connected with said IC card driver and said communication system for receiving said signal transmitted from said activation device to activate said mobile phone, thereby communicating with said others (Figure 2, Figure 3A, Figure 3B, Column 3 lines 18 – 67, Column 4 lines 1 – 61, Column 5 lines 29 – 67, Column 6 lines 1 – 20, mobile subscriber unit encompasses a mobile phone, mobile subscriber unit is the communication system for communicating with others, Local Link Data Interface is the access module, SIM Command/Response Interface is the IC card driver, a hand-shaking protocol is conducted via a wireless bi-directional link between the mobile subscriber unit and the server/activation device that houses the SIM such that the said mobile subscriber unit becomes active and said mobile subscriber unit can have access to the SIM database for subscriber specific data, the system architecture of the mobile subscriber unit that enables said hand-shaking and subscriber specific data access via said wireless bi-directional link comprises integrated circuits thus an inherent IC card driver and access module are taught).

Regarding Claim 2, Pecen teaches all of the claimed limitations recited in Claim 1. Pecen further teaches a mobile phone wherein said activation device comprises an

integrated circuit (IC) card and a transmitter (Figure 3A, Column 3 lines 39 – 67, Column 4 lines 1 – 61, local link transceiver is the transmitter of server/activation device, the system architecture of the server/activation device comprises integrated circuits thus an inherent IC card is taught).

Regarding Claim 3, Pecan teaches all of the claimed limitations recited in Claim 2. Pecan further teaches a mobile phone wherein said IC card records an identification data for being recognized by said access module (Figure 2, Figure 3A, Column 3 lines 46 – 57, the SIM stores the subscriber specific data that the mobile subscriber units can access via a wireless link such that said mobile subscriber units can be personalized thus an inherent recording of identification data/subscriber specific data is taught).

Regarding Claim 8, Pecan teaches all of the claimed limitations recited in Claim 1. Pecan further teaches an access module that detects said signal transmitted from said activation device and said IC card driver activates said communication system (Figure 2, Figure 3A, Figure 3B, Column 3 lines 18 – 67, Column 4 lines 1 – 61, Column 5 lines 29 – 67, Column 6 lines 1 – 20, mobile subscriber unit is the communication system for communicating with others, Local Link Data Interface is the access module, SIM Command/Response Interface is the IC card driver, a hand-shaking protocol is conducted via a wireless bi-directional link between the mobile subscriber unit and the server/activation device that houses the SIM such that the mobile subscriber unit becomes active and said mobile subscriber unit can have access to the SIM database for subscriber specific data, the system architecture of the mobile subscriber unit that enables said hand-shaking and subscriber specific data access via said wireless bi-

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directional link comprises integrated circuits thus an inherent IC card driver and access module are taught).

***Claim Rejections - 35 USC § 103***

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claims 4 and 5 are rejected under 35 U.S.C. 103(a) as being unpatentable over Pecen et al. (US 6,466,804 B1) in view of Peters (US 6,601,093 B1).

Regarding Claim 4, Pecen teaches all of the claimed limitations recited in Claim 2. Pecen further teaches a signal that is transmitted from said activation device to activate said communication system to get communication with said others (Figure 2, Figure 3A, Figure 3B, Column 3 lines 18 – 67, Column 4 lines 1 – 61, Column 5 lines 29 – 67, Column 6 lines 1 – 20, mobile subscriber unit is the communication system to get communication with others, a hand-shaking protocol is conducted via a wireless bi-directional link between the mobile subscriber unit and the server/activation device that houses the SIM such that the said mobile subscriber unit becomes active and said mobile subscriber unit can have access to the SIM database for subscriber specific data).

Pecen does not specifically teach automatically detecting the distance between said activation device and said mobile phone such that when said activation device approaches a specific distance from said mobile phone the communication system is activated to get communication with said others.

Peters teaches the method of automatically detecting a distance between a wireless device and a mobile phone, and when said wireless device approaches said mobile phone in a specific distance, a signal is transmitted from said wireless device to mobile phone to establish a wireless connection (Column 6 lines 44 – 67, Bluetooth is a wireless protocol therefore in order for the presence of a Bluetooth enabled device to be detected the distance has to be detected thus an inherent distance detection is taught, hand-shaking is conducted between the Bluetooth enabled devices such that a wireless connection is established).

Pecen (Column 3 lines 20 – 32) and Peters both teach wireless devices that establish wireless bi-directional links via a Bluetooth protocol thus it would have been obvious to one of ordinary skill in the art at the time the invention was made to use the Bluetooth protocol taught in Peters as the local wireless link such that a local wireless connection between the server/activation device and the mobile subscriber unit in Pecan is enabled.

Regarding Claim 5, Pecan teaches all of the claimed limitations recited in Claim 1. Pecan further teaches an activation device that is carried on a user and said communication system is activated by said activation device (Figure 2, Figure 3A, Figure 3B, Column 3 lines 18 – 67, Column 4 lines 1 – 61, Column 5 lines 29 – 67,

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Column 6 lines 1 – 20, mobile subscriber unit is the communication system, a hand-shaking protocol is conducted via a wireless bi-directional link between the mobile subscriber unit and the server/activation device that houses SIM such that the mobile subscriber unit becomes active and said mobile subscriber unit can have access to the SIM database for subscriber specific data, server/activation device is a mobile subscriber unit which means that it can be carried with the user).

Pecen does not specifically teach the method of activating the communication system when said activation device approaches a specific distance from said mobile phone.

Peters teaches the method of establishing a wireless link between a wireless device and a mobile phone when said wireless device approaches a specific distance from said mobile phone (Column 6 lines 44 – 67, hand-shaking is conducted between the Bluetooth enabled devices such that a wireless connection is established).

Pecen (Column 3 lines 20 – 32) and Peters both teach wireless devices that establish wireless bi-directional links via a Bluetooth protocol thus it would have been obvious to one of ordinary skill in the art at the time the invention was made use the Bluetooth protocol taught in Peters as the local wireless link such that a local wireless connection between the server/activation device and the mobile subscriber unit in Pecan is enabled.



7. Claims 6 and 7 are rejected under 35 U.S.C. 103(a) as being unpatentable over Pecen et al. (US 6,466,804 B1) in view of Peters (US 6,601,093 B1) and in further view of Kennedy et al. (US 6,377,825 B1).

Regarding Claim 6, Pecen in view of Peters teaches all of the claimed limitations recited in Claim 5. Pecen in view of Peters does not specifically teach a mobile phone that is used in a vehicle.

Kennedy teaches a mobile phone that is used in a vehicle (Abstract, Figure 1A, Column 5 lines 8 – 25).

Pecen in view of Peters and Kennedy teach a mobile subscriber units that establish wireless bi-directional links via a Bluetooth protocol thus it would have been obvious to one of ordinary skill in the art at the time the invention was made to use the hands free device taught in Kennedy in the wireless system of Pecen in view of Peters such that a user could operate the mobile subscriber unit hands free thereby alleviating the danger associated with simultaneously driving the vehicle and operating said mobile subscriber unit.

Regarding Claim 7, Pecen in view of Peters and in further view of Kennedy teaches all of the claimed limitations recited in Claim 6. Kennedy further teaches a mobile phone that is combined with an audio system in said vehicle (Figure 3, Figure 4A, Column 10 lines 34 – 48).

### **Conclusion**

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8. Any inquiry concerning this communication should be directed to Raymond S.

Dean at telephone number (703) 305-8998.

If attempts to reach examiner by telephone are unsuccessful, the examiner's supervisor, Nay Maung, can be reached at (703) 308-7745. Any response to this action should be mailed to:

Commissioner of Patents and Trademarks

Washington, D.C. 20231

Or faxed to:

(703) 872-9314 (for Technology center 2600 only)

Hand – delivered responses should be brought to Crystal Park II, 2121 Crystal Drive, Arlington, VA, Sixth Floor (Receptionist). Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Technology Center 2600 Customer Service Office whose telephone number is (703) 306-0377

*Theric Cowan*

*Raymond S. Dean*